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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Gately et al.

Confirmation No.:

Serial No.: 09/401,839

Art Unit: 1646

Filed: September 22, 1999

Examiner: Mertz, Prema Maria

For: PURIFICATION AND
CHARACTERIZATION OF
CYTOTOXIC LYMPHOCYTE
MATURATION FACTOR AND
MONOCLONAL ANTIBODIES
THERE TO

Attorney Docket No: 11126-004

SUPPLEMENTAL RESPONSE TO FINAL OFFICE ACTIONAssistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In further response to the outstanding final Office Action, dated February 22, 2002, Applicants submit the following remarks. Concurrently herewith, Applicants submit a Request for Continued Examination and a Petition for Extension of Time 37 C.F.R. § 1.136(a) (extending the time to file an appeal brief for one additional month, to and including March 22, 2003).

On January 23, 2003, Applicants submitted a Request Under 37 C.F.R. §§ 1.607 and 1.608(b) for Interference With Patent No. 5,811,523 ("Request for Interference"), Declaration of Dr. William R. Benjamin, Declaration of Thomas E. Friebe Under 37 C.F.R. §§ 1.607 and a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) (extending the time to file an appeal brief for four months, to and including February 22, 2003).

Applicants' Request for Interference responded specifically to the outstanding Office Action. See pages 51-52, particularly the section entitled "Specific Comments on the

NY2: 1414943.1

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being filed with the United States Patent and Trademark Office by facsimile transmission on Mar 24, 2003 to facsimile telephone number 705-746-5300.

Thomas E. Friebe

29,258
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Examiner's Position."

Moreover, pursuant to M.P.E.P. § 2307.01 (8th ed., August 2001), Applicants submit that the prior-filed Request for Interference is fully responsive to the outstanding Office Action. Section 2307.01 provides:

The presentation of claims corresponding to claims of a patent when not suggested by the Office does not constitute a reply to the last Office action *unless the last Office action relied solely on the patent for the rejection of all the claims rejected in that action.*

(Emphasis added.) Applicants note that Section 2307.01 does *not* require that the presentation of claims (here, the Request for Interference) have been acted upon by the Office in order for it to constitute a reply to the Office Action.

Applicants' present situation falls squarely within italicized exception of Section 2307.01 because the Office Action, dated February 22, 2002 (Paper No. 19), contains only two rejections, both of which are based on Trinchieri *et al.* Patent No. 5,811,523 ("523 patent"), which is the patent that is the subject of Applicants' Request for Interference. Applicants' Request for Interference presents claims corresponding to *all* of the claims of the '523 patent and requests that *all* claims of the patent (claims 1-7) be involved in an interference with *all* claims of the captioned application (claims 33-38 plus claims 39-44 that were added in the Request for Interference). Thus, Applicants' presentation of claims corresponding to all claims of the '523 patent constitutes a complete response to the outstanding Office Action pursuant to Section 2307.01.

The two rejections of the outstanding Office Action are for anticipation under 35 U.S.C. § 102(e) and obviousness under 35 U.S.C. § 103 over the '523 patent. Applicants contend that all claims of their application are directed to the same patentable inventions as all claims of the '523 patent. Therefore, Applicants cannot distinguish their claims from the claims in the patent. Nor can Applicants antedate the patent under 37 C.F.R. § 1.131, since subpart (a) prohibits establishing prior invention if the rejection is based on a U.S. patent to another which claims the same patentable invention as defined in 37 C.F.R. § 1.601(n).

Nevertheless, to the extent additional response to the outstanding rejections is necessary, Applicants point to those sections of their Request for Interference that demonstrate that the '523 patent is not entitled to a filing date before the effective filing date of Applicants' claims. Specifically, Sections V (pages 27-39) and VI (pages 39-43) demonstrate that Trinchieri *et al.* are not entitled to the benefit of the filing date of application Serial No. 269,945, filed November 10, 1988 or the filing date of application Serial No. 307,817, filed February 7, 1989. Thus, the earliest potential effective filing date for the claims of the '523 patent is the September 18, 1990 filing date of Trinchieri *et al.*'s

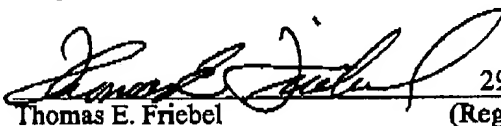
application Serial No. 584,941. Section VII (pages 43-46) shows that Applicants are entitled to the benefit of the August 27, 1990 filing date of their application Serial No. 572,284. Thus, in the Request for Interference, Applicants have shown that Applicants' effective filing date (August 27, 1990) is prior to the effective filing date (September 18, 1990) of the '523 patent for the subject matter of Applicants' claims 33-44 and all claims of the '523 patent. Therefore, both rejections based on the '523 patent are without merit because the patent is not prior art to Applicants' claims. An interference should be declared to remove the '523 patent claims and provide for issuance of Applicants' application.

Moreover, Applicants also point to Section X of their Request for Interference (pages 47-50), which demonstrates that all claims of the '523 patent are unpatentable to Trinchieri *et al.* For this additional reason, the rejections based on the '523 patent should be withdrawn and an interference declared.

Applicants respectfully submit that the appropriate remedy here is the declaration of an interference with the two counts and claim designations set forth in their Request for Interference. Prompt action to that end is respectfully requested. See 37 C.F.R. § 1.607(b) and M.P.E.P. § 2307 (see subsection entitled "Special Dispatch").

Respectfully submitted,

Date: March 24, 2003


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